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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/501,408	02/10/2000	Frederic Serre	A32979-070337.0181	3806
21839 7590 04/02/2007 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER SHOSHO, CALLIE E	
			ART UNIT 1714	PAPER NUMBER
			MAIL DATE 04/02/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/501,408

Applicant(s)

SERRE, FREDERIC

Examiner

Callie E. Shosho

Art Unit

1714

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 16 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 23-42.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

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**Attachment to Advisory Action**

1. Applicants' amendment filed 3/16/07 has been fully considered, however, the amendment has not been entered given that the amendment raises new issues that would require further consideration and search.

Specifically, the amendment raises new issues that would require further consideration under 35 USC 112, second paragraph in light of the amendment to claim 23 which has been amended to recite "wherein the amount of silica is from 25 phr to 40 phr". Given that claim 23 also recites that the blend of carbon black and silica is in an amount between 15 phr and 50 phr and that the amount of silica is greater than or equal to the amount of carbon black in phr minus 5, the scope of the claim is confusing given that it is not clear how the composition can both comprise blend of carbon black and silica in amount between 15 phr and 50 phr and have amount of silica from 25 phr to 40 phr. That is, for instance, given that the minimum amount of silica is 25 phr, it is not clear how the lower limit of the amount of the blend of carbon black and silica is 15 phr. It would appear that the lower limit of the blend amount of carbon black and silica would necessarily have to be greater than the amount of silica alone.

Further, the amendment raises new issues that would require further consideration and search in light of the amendment to claim 23 which has been amended to recite "where the amount of silica is from 25 phr to 40 phr". Previously, there was no limitation present in claim 23 regarding the amount of silica present. Thus, whereas previously the claim encompassed any amount of silica and carbon black such that the blend amount was between 15 phr and 50 phr and the amount of silica was greater than or equal to the amount of carbon black in phr minus 5, now

the claim is further limited to amount of silica that is from 25 to 40 phr. Such narrowing of the scope of claim 23 would clearly require further consideration and search.

It is noted that even *if* the amendment filed 3/16/07 were entered, the claims would not be allowable over the cited prior art for the following reasons.

Applicants argue that Segatta et al. (U.S. 6,776,206) is not a relevant reference against the present claims given that there is no disclosure in Segatta et al. that the composition comprises more than 70 phr natural rubber or synthetic polyisoprene. Applicants note that the data in Tables I and II (examples) of Segatta et al. show that polybutadiene is used in very high amount compared to the amount of natural rubber.

It is agreed that there are no examples in Segatta et al. that utilize natural rubber or synthetic polyisoprene in amount as presently claimed. However, “applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others”, *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, “nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims”, *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). A fair reading of the reference as a whole clearly discloses the use of 80-97 parts of at least one diene rubber which includes natural rubber or synthetic cis-1,4-polyisoprene rubber (col.2, lines 52-55). Thus, it is the examiner’s position that Segatta et al. do meet the requirements of the present claims with respect to the amount of natural rubber or synthetic polyisoprene.

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It is further noted that *if* the amendment filed 3/16/07 were entered, the amendment would overcome the 35 USC 112, first paragraph rejection of record.



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CS  
3/27/07